

## **REMARKS**

### **A.     35 U.S.C. § 102**

In the Office Action of August 7, 2003, claims 1, 2, 4-12, 14 and 16-23 were rejected under 35 U.S.C. §102(b) as being anticipated by Curtis. Applicant traverses this rejection for several reasons. First, claims 1 and 14 have been canceled and so their rejections have been rendered moot and should be withdrawn. Regarding the remaining claims, claims 2 and 16 have been amended to be in independent form and recite transmitting a digital signal in a defined serial transmission protocol to an electronic evaluation unit. The Office Action has asserted that column 5, lines 20+ disclose converting a value into a digital signal. However, this passage recites a digital to analog conversion of the output of an up/down counter which is arranged in box 32 in FIG. 1A. (Col. 5, ll. 21-25). Accordingly, claims 2 and 16 are not anticipated by Curtis and so the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that Curtis does not disclose transmitting a digital signal in a defined serial transmission protocol. The Office Action also asserts that serial transmission is disclosed in Curtis at column 2, lines 49+. A review of this passage only discloses that an error signal e is somehow digitally processed. There is no mention of serial transmission of a converted controlling variable. Accordingly, claim 2 is not anticipated by Curtis and so the rejection is improper and

should be withdrawn.

Besides not being anticipated by Curtis, claims 2 and 16 are not rendered obvious by Curtis. In particular, there is no suggestion or motivation to transmit a digital signal in a defined serial transmission protocol to an electronic evaluation unit. Without such motivation, claim 2 is patentable over Curtis.

As mentioned above, claims 2 and 16 have been amended so as to be in independent form. Since the amendment incorporates subject matter that was inherently present in original claims 2 and 16, the amendment is not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

Claims 4-6, 9, 10, 12, 19, 21 and 22 have been amended so as to depend from either claim 2 or 16 and are being presented to provide additional coverage for either the method for operation of a position measuring device as recited in claim 2 or the position measuring device of claim 16. Accordingly, the amendments of claims 4-6, 9, 10, 12, 19, 21 and 22 are not being presented for reasons of patentability as defined in *Festo*.

**B. 35 U.S.C. §103**

**1. Claim 9**

Claim 9 was rejected under 35 U.S.C. §103 as being obvious in view of Curtis.

Claim 9 depends from claim 2. As mentioned above in Section A, there is no suggestion or motivation in Curtis to transmit a digital signal in a defined serial transmission protocol to an electronic evaluation unit. Without such suggestion or motivation, the rejection is improper and should be withdrawn.

Claim 9 has been amended so as to depend from claim 2 and is being presented to provide additional coverage for the method for operation of a position measuring device as recited in claim 2. Accordingly, the amendment of claim 9 is not being presented for reasons of patentability as defined in *Festo*.

**2. Claims 3, 8 and 15**

Claims 3, 8 and 15 were rejected under 35 U.S.C. §103 as being obvious in view of Curtis and Schwefel. Claims 3, 8 and 15 depend directly or indirectly from claim 2 or claim 16. Schwefel does not overcome the deficiencies of Curtis with respect to claims 2 and 16 as mentioned in Section A, since Schwefel does not suggest having Curtis transmit a digital signal in a defined serial transmission protocol to an electronic evaluation unit. Without such suggestion or motivation, the rejection is improper and should be withdrawn.

Please note that claims 3 and 15 have been amended so as to depend from either claim 2 or 16 and are being presented to provide additional coverage for either the method for operation of a position measuring device as recited in claim 2 or the position

measuring device of claim 16. Accordingly, the amendments of claims 3 and 15 are not being presented for reasons of patentability as defined in *Festo*.

**3. Claims 24-34**

Claims 24-34 were rejected under 35 U.S.C. § 103 as being obvious in view of Curtis and Schwefel. Applicant traverses this rejection since claim 24 has been canceled and so its rejection has been rendered moot and should be withdrawn. Regarding the remaining claims, claim 26 has been amended to be in independent form and recites “setting a scanning spacing between said scanning plane and said measuring graduation plane with the aid of said displayed value of said variable that directly corresponds to said actual scanning spacing.” The Office Action has conceded that Curtis does not disclose such setting. The Office Action has relied on Schwefel as curing the deficiencies of Curtis. While Schwefel does disclose an interpolation apparatus for a digital electronic position measuring instrument, it is silent as to setting a scanning spacing between the scanning plane and measuring graduation plane via a displayed value of the recited variable. Evidence of this silence is the fact that the Office Action has not identified any portion of Schwefel that discloses such setting. Since there is no motivation in Schwefel to perform the recited setting of claim 26 in the method of Curtis, the rejection is improper and should be withdrawn.

As mentioned above, claim 26 has been amended so as to be in independent form. Since the amendment incorporates subject matter that was inherently present in original claim 26, the amendment is not being presented for reasons of patentability as defined in *Festo*.

Claims 25, 27-29, 31, 32 and 34 have been amended so as to depend from claim 26 and are being presented to provide additional coverage for the method for operation of a position measuring device as recited in claim 26. Accordingly, the amendments of claims 25, 27-29, 31, 32 and 34 are not being presented for reasons of patentability as defined in *Festo*.

**C. New Claims 35 and 36**

New claims 35 and 36 depend directly on independent claims 2 and 16, respectively. Accordingly, claims 35 and 36 are patentable for at least the same reasons given above in Section A.

Claims 35 and 36 have been presented to provide additional coverage for either the method for operation of a position measuring device as recited in claim 2 or the position measuring device of claim 16. Accordingly, the claims 35 and 36 are not being presented for reasons of patentability as defined in *Festo*.

### CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 2-12, 15-23 and 25-36 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J.C. Freeman", is written over a horizontal line.

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